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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/077,723

02/14/2002

C.J. Anthony Fernando

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11/02/2004

Varian Inc.

Legal Department

3120 Hansen Way D-102

Palo Alto, CA 94304

EXAMINER

PAK, SUNG H

ART UNIT

PAPER NUMBER

2874

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/077,723

Applicant(s)

FERNANDO ET AL.

Examiner

Sung H. Pak

Art Unit

2874

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 12 and 14-17.

Claim(s) rejected: 12,13 and 22.

Claim(s) withdrawn from consideration: 25-48.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: Claim 12 is amended to include SOME limitations of claim 14. The amendment changes the scope of claim 12 which would require further consideration.

Continuation of 5. does NOT place the application in condition for allowance because:

Regarding Restriction requirement:

On page 14 of the applicant's response, the election requirement is traversed on the ground that 1)"subclasses 15 and 16 cover very similar subject matter" 2) examination of both groups does not pose a serious burden on the examiner 3) "claims 25-38, 43 and 44 would have been classified in the same class as claims 1-11 and 23, for which a search and examination have already been made."

The examiner respectfully submits that:

- 1) Even if we assume, for the sake of argument, that subclasses 15 and 16 indeed cover very similar subject matter, the restriction requirement is proper because the particulars of the subcombination as claimed are not required for patentability of the combination as claimed in the instant application. As such, the search and analysis of these two groups of claims would inherently involve two patentably distinct sets of limitations. Therefore, search and analysis required for one group is not required for the other group, and the restriction is proper. MPEP 806.05(c).
- 2) As discussed above, the examination of both groups cannot involve a single search. Even if both groups CAN be classified in a single common subclass, the actual search for recited limitations involves searching of plurality of subclasses (such as subclass 12, 15, 16, 25, 26, etc.), including various text search strategies. Conducting a search for two patentably distinct inventions with distinct and independent limitations pose serious burden on the examiner and the restriction is proper.
- 3) The original claims 1-11 and 23 (which were subsequently cancelled in an earlier amendment) involve different scope and permutations of limitations compared to the newly added claims 25-38, 43 and 44. Thus, the same search and analysis performed for the original claims 1-11 and 23 no longer applies to the newly added claims 25-48, and the restriction is proper.

On page 17, it is argued that amended claim 12 overcomes the prior art rejection based on Kassel et al. As stated above, the amendment changes the scope of the claim 12 which would require further consideration.



Sung Pak
Patent Examiner
AU 2874



Rodney Bovernick
Supervisory Patent Examiner
Technology Center 2800